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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09711261

Filing Date: 10 November 2000

Appellant(s): John DeMAYO et al.

Anthony J. Lombardi, Esq., For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6 April 2006 appealing from the Office action mailed 5 October 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Bull et al., US005995943A, 30 November 1999

Murray, US006061659A, 9 May 2000

Kirsch, US006189030B1, 13 February 2001

Official notice was taken that that the added limitations of claims 3, 7, 11, 14-15, 22 and 25 were common knowledge or well known in the art. Said limitations were taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. A rejection under 35 USC § 112 now withdrawn has been omitted. The following is otherwise a verbatim copy of the final rejection mailed on 5 October 2005.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 11 July 2005 have been fully considered, but they are not persuasive. The arguments are addressed by a rejection rewritten for clarity and discussed explicitly at para. 10 below.

Claim Rejections - 35 USC § 102 and 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2, 4-6, 9-10, 12-13, 21, 24 and 31 are rejected under 35 U.S.C. 102(e) as being as anticipated by Bull et al. (US005995943A).

7. Bull et al. teaches (independent claims 1, 9, 21 and 24) an apparatus and method for hyperlinking specific words in content or in text-containing files, or displayed in an application, to convert the words into advertisements, the method comprising: connecting a content provider server to the Internet, said content provider having content files to be displayed (col. 3 lines 31-34 and 66-67); providing an advertiser web page so as to be accessible over the Internet (the *Advertising DataStore* ***250***, col. 12 lines 32-34 and Fig. 2); and connecting an ad server (*advertiser's computer system* ***400***, col. 8 line 10 and Fig. 1) to the Internet, wherein the ad server provides *hot links* (col. 8 line 19-21), which reads on hypertext links or hyperlinks (Microsoft Press Computer Dictionary), to convert at least one existing word (e.g., *Holiday Inns on the West Coast*, col. 15 lines 39-42) present in a content file into one or more advertisements (e.g., an ad for *Hilton Inns on the West Coast*) by linking an Internet-enabled web browsing device (*network addressable interface device*, col. 3 lines 28-29) connected to the Internet to said advertiser web page (col. 15 lines 30-33). Bull et al also teaches the hypertext link at col. 3 lines 56-58. Bull et al. also teaches (claims 1 and 21) a terminal (*user access system* ***100***) for connection to the Internet.

8. Bull et al. also teaches that said word or phrase is advertiser-chosen. The reference teaches that the advertiser chooses the criteria by which the ads are placed (col. 8 lines 3-5 and 19-22), said advertiser-chosen criteria being used to choose said word(s) (col. 15 lines 24-29).

9. Bull et al. does not explicitly teach a hypertext anchor to said advertiser-chosen word. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches ads hyperlinked (col. 3 lines 56-58 and col. 8 lines 19-21) to pages based on keywords in the content of that page (col. 15 lines 24-29). If a hyperlink is executed from text, there must be a hyperlink anchor at said text (Microsoft Press Computer Dictionary definition 2 of "anchor"). Since the hyperlink is executed by the

appearance of the keyword(s) or advertiser-chosen word or phrase, the anchor is, by definition, at said advertiser-chosen word or phrase.

10. Applicant argues repeatedly at pp. 11-14 that the reference does not teach that the ad server "provides a hypertext anchor to convert at least one existing advertiser chosen word present in a context file by linking said at least one existing advertiser chosen word to said advertiser web page". In detail from para. 7-9 above:

    The teaching of a hypertext anchor is inherent from the teaching of hypertext links or *hot links* at col. col. 3 lines 56-58 and col. 8 lines 19-21. See para. 9 above.

    The chosen word(s) present in a context file, *Holiday Inns on the West Coast*, are taught at col. 15 lines 39-42.

    Para. 8 above explains that said word(s) are advertiser chosen.

    The advertiser web page accessible over the Internet is taught as *Advertising DataStore **250*** (col. 12 lines 32-34 and Fig. 2), and linking to said advertiser web page is taught at col. 15 lines 30-33.

11. Bull et al. does not explicitly teach (independent claim 31) displaying a description of the advertiser web page when a mouse pointer is positioned over the hyperlink. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, the reference teaches clicking on a URL (col. 14 lines 50-52), in order to access a Web page. The mouse pointer must inherently be positioned over the URL link in order to activate said link by clicking on it.

12. Bull et al. also teaches at the citations given above claims 2, 4-6, 10, 12 and 13.

13. Claims 3, 7, 11, 14-15, 22 and 25 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. Bull et al. does not teach (claims 3, 11, 22 and 25) using a script to provide a hypertext anchor and (claims 7 and 14-15) using frames to display the content provider URL in a browser window. It was common, at the time of the instant invention, to use script to provide a hypertext anchor and display the URL of content in a browser window using frames. Because it is efficient to use common and well known practices, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to

add to the teachings of Bull et al. the use of script to provide a hypertext anchor and the use of frames to display the content provider URL in a browser window.

14. Official notice of this common knowledge or well known in the art statement was taken in the last Office action (mailed 2 August 2004, para. 11). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).

15. Claims 8, 16, 23 and 26 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Kirsch et al. (US006189030B1). Bull et al. does not teach linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines 14-26), which reads on a tracking URL. Because Kirsch et al. teaches that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al.

16. Claims 17-19, 27-29 and 31 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray (US006061659A).

17. Bull et al. does not teach (independent claims 17 and 27) the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor. Murray teaches the advertiser compensating at least one of a content provider and an entity that selects said hypertext anchor (col. 8 lines 19-20). Because it facilitates the acceptance of advertising (col. 2 lines 22-24), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Murray to the teachings of Bull et al.

18. Murray also teaches claims 18 and 28 at the citation given above.

19. Claims 19, 20, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray and further in view of Kirsch et al.

20. Neither Bull et al. nor Murray teaches (claims 20 and 30) linking to said advertiser web page using a tracking URL. Kirsch et al. teaches linking to said advertiser web page (*the external server* system, col. 7 lines 10-17) using a tracking server system (col. 5 lines

14-26), which reads on a tracking URL. Because that tracking clicks is important (col. 2 lines 34-38 and col. 6 lines 60-61) and that the reference invention does so expediently, with minimum latency and visibility (col. 5 lines 33-37), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Kirsch et al. to the teachings of Bull et al. and Murray.

21. Kirsch et al. also teaches claims 19, 29 and 32 (col. 2 lines 29-38).

(10) Response to Argument

A. Argument against the rejection of claims 1-2, 4-6, 9-10, 12-13, 21, 24 and 31 under 35 U.S.C. 102(e) as being anticipated by Bull et al.

Appellant argues (p. 13, 2nd para.),

> "Claim 1 recites an apparatus for hyperlinking specific words in content to turn the words into advertisements including, among other things, 'means for providing a hypertext anchor to *convert at least one existing advertiser-chosen word present in a content file into an advertisement* by linking said at least one advertiser-chosen word to said advertiser web page' (emphasis added). Bull does not teach at least this element of claim 1."

Appellant makes his argument by focusing (top of p. 13) on a sentence referred to in para. 10 of the rejection,

> "As an example, if the user accesses web pages for 'Holiday Inns on the West Coast', the insertion mechanism would be established to automatically insert ads for 'Hilton Inns on the West Coast'." (Bull et al., col. 15, lines 39-42)

Appellant submits these three lines as evidence that the ads are literally inserted into a web page, not presented via hyperlink. Appellant goes on to cite the phrase "GET AD TO INSERT" from Fig. 6, and notes that ads are "added into the display" at col. 12, lines 15-16 of thee reference.

As a matter of fact, the examiner counted a total of 29 uses of "insert" or "insertion" in the reference. One instance speaks of "direct insertion" of an ad (col. 12 line 16). In at least that one case, and possible others, the examiner acknowledges that the reference could be teaching the literal insertion of ads.

However, in most of the 29 uses of insert/insertion, the examiner believes that the term is being used more broadly to mean placement by any means, by hyperlink, for example. As noted in the rejection, the reference does teach placement by hyperlink:

> "On the World Wide Web (WWW), a technology called hypertext allows Internet addressable resources to be connected, or linked, to one another." (Bull et al., col. 1 lines 30-32)
>
> "This information is topically oriented (Germany travel, the Olympics, Spring Break or even new cars), composed of files and file references using the Hypertext Markup Language ("HTML") or similar tagged reference format that may be prescreened for relevance and appropriateness. Selected text can be "expanded" at any time to provide other information. These words are, thus, linked to other documents." (Bull et al., col. 3 lines 51-58)
>
> "The ad/coupon may be resident on the user access system **100**, an advertiser's computer system (400 . . . N) or stored in the Advertising DataStore **250**. Additionally, the Advertiser may include conditional criteria for ad/coupon placement (available inventory, in stock levels, excess capacity, etc.). This criteria is referenced when the "threshold" is met and if satisfactory, the ad/coupon is appended. This criteria may be tested against data input through the user access system 100, data on the advertising DataStore 250 or data on the advertiser's computer system (400 . . . N). Additionally, advertisers can input World Wide Web (WWW) referential information (hot links)[1] to be displayed with ads/coupons or on geographic map displays. These are stored on the advertising DataStore 250." (Bull et al., col. 8 lines 9-22)
>
> "Geographic Display I/O System 287--This allows the user to view content geographically, to look at the geographic proximity of merchants and services and provides a vehicle for ads and hot links. (Bull et al., col. 10 lines 49-52)
>
> "The URLs embedded in each page that pass through are indexed by the present invention or "munged" so that any hyper linking to another WWW site always goes through the present invention. As an example, "WWW.anywhere.com" is converted

[1] As noted in the rejection, "hot links" is an early term for hyperlinks.

> to "WWW.travelgenie.com? WWW.anywhere.com", even though the user will see a direct path to the distant site." (Bull et al., col. 14 lines 43-49)

Hence, it matters not what means of placement is being suggested by Bull et al. at col. 15, lines 39-42. A reference is available for all that it teaches, and Bull et al. teaches ad placement by hyperlink.

Appellant addresses (pp. 14-15) rejection para. 11 with respect to claim 31. The substance of the argument is at the last para. of p. 15, where appellant argues that the reference does not teach displaying a description of the advertiser web page. It is true that the citation given by the rejection (col. 14 lines 50-52) only teaches connecting to the requested site. However, the reference also teaches

> "If a certain web page is requested, the present invention will display a particular advertisement." (Bull et al., col. 17-19)

B. Argument against the rejection of claims 3, 7, 11, 14-15, 22 and 25 under 35 U.S.C. 103(a) as being obvious over Bull et al.

Appellant adds no new arguments. Official notice was taken that that the added limitations of claims 3, 7, 11, 14-15, 22 and 25 were common knowledge or well known in the art. These additional limitations are taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.).

C. Argument against the rejection of claims 8, 16, 23 and 26 under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Kirsch et al.

Appellant adds no new arguments.

D. Argument against the rejection of claims "17-19, 27-29 and 31" under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray.

Appellant adds no new arguments. Appellant does correctly note that there is error in the list of clams rejected. In place of claim "31" the list should have included claim 32, so as to read "Claims 17-19, 27-29 and 32 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray (US006061659A)." For claims 19 and 29, the citation to the teaching was inadvertently omitted; it is col. 2, line 51, in Murray.

E. Argument against the rejection of claims 19, 20, 29, 30 and 32 are rejected under 35 U.S.C. 103(a) as being obvious over Bull et al. in view of Murray and further in view of Kirsch et al.

Appellant adds no new arguments. (The rejection is strictly correct, although redundant for claims 19, 29 and 32. These added limitations are taught by both Murray and Kirsch et al., and were rejected at two places in the Office action.)

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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